



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

10/693,656

10/24/2003

Igor Dozmorov

OMRF-013US

9649

7590 01/18/2007  
Michael C. Barrett, Esq.  
FULBRIGHT & JAWORSKI, L.L.P.  
Suite 2400  
600 Congress Avenue  
Austin, TX 78701

EXAMINER

MILLER, MARINA I

ART UNIT

PAPER NUMBER

1631

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
--	-----------	---------------

3 MONTHS

01/18/2007

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

# Office Action Summary

Application No.

10/693,656

Applicant(s)

DOZMOROV ET AL.

Examiner

Marina Miller

Art Unit

1631

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 06 October 2006.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-9 and 11-13 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-9, 11-13 is/are rejected.
- 7) ☒ Claim(s) 11 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a). Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
- Paper No(s)/Mail Date \_\_\_\_\_

- 4) ☐ Interview Summary (PTO-413)
- Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

### DETAILED ACTION

Applicants' submission filed on 10/6/2006 is acknowledged.

Claims 1-9 and 11-13 are pending.

Claim 10 is cancelled.

Claims 1-9 and 11-13 presently are under examination.

Applicants' arguments have been fully considered. Rejections and/or objections not reiterated from previous office actions are hereby withdrawn. The following rejections and/or objections are applied.

#### *Claim Objections*

Claim 11 is objected to because of the following informalities: claim 11 depends from cancelled claim 10. Appropriate correction is required.

#### *Claim Rejections - 35 USC § 101*

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-9 and 11-13 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Claims 1 and 13 are directed to a method of associative analysis comprising steps of collecting expression profiles of control and experimental groups, normalizing expression profiles of control and experimental groups relative to their backgrounds, adjusting expression profiles to identify outliers and to re-scale to an average profile of the control group, identifying

similarly expressed groups from the control group, identifying expressed genes by t-tests, and classifying expressed genes as likely false positive, real positive, and potential positive using a t-test. However, not all processes are statutory under 35 U.S.C. 101. *See* MPEP 2106 (Section IV in particular). To satisfy 101 requirements, the claim must be for a practical application, which can be met if the claimed invention “transforms” an article or physical object to a different state or thing OR the claimed invention otherwise produces a useful, concrete, and tangible result. If claims are directed to abstract ideas (such as mathematical algorithms), natural phenomena, and laws of nature, the claims must be considered as a whole for determining whether an abstract ideas, natural phenomena, or laws of nature has a particular application.

In the instant case, the claimed method steps “describe nothing more than the manipulation of basic mathematical constructs, the paradigmatic ‘abstract idea.’” MPEP 2106 Section IV. Specifically, the claimed method recites mathematical and/or statistical manipulations of data representing expression profiles. The step of collecting expression profiles does not necessarily mean conducting hybridization experiments between a sample and an array; it may simply encompass retrieval of previously obtained hybridization data from a computer and/or a database. The claimed method does not transform or reduce an article or a physical object to a different stage or thing because the “result” of the method (*i.e.*, classified expression profiles) is merely data (gene expression information) and is not equivalent to physical transformation. The claims do not recite tangible expression (*i.e.*, real-world result) of classifying expression information, nor any recitation of an actual (*i.e.*, concrete) result in a form useful to one skilled in the art. Thus, the method does not recite steps of producing something that is concrete, useful, and tangible, and is not statutory.

***Claim Rejections - 35 USC § 102***

***Affidavit under 37 CFR 1.131***

The Declaration and evidence filed under 37 CFR 1.131 by Dr. Igor Dozmorov, on 10/6/2006, has been fully considered. The Declaration is sufficient to overcome the rejection under 35 U.S.C. 102(a) of claims 1, 3-5, 8-9, and 12 as being anticipated by Xiao, *BMC Genomics*, 3:28 (pages 1-11) (27 Sept. 2002). Thus, the rejection under 35 U.S.C. 102(a) of claims 1, 3-5, 8-9, and 12 over Xiao is hereby withdrawn.

***Claim Rejections - 35 USC § 103***

In view of the claim amendments filed 10/6/2006, the rejections under 35 U.S.C. 103(a) are hereby withdrawn.

***Conclusion***

No claims are allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Marina Miller whose telephone number is (571)272-6101. The examiner can normally be reached on 8-6, M-Thu.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Wang, Ph. D. can be reached on (571)272-0811. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 1631

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Marina Miller  
Examiner  
Art Unit 1631

MM

MARJORIE A. MORAN  
PRIMARY EXAMINER

*Marjorie A. Moran*  
1/4/07